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No. 87-194

IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1987

TI-COATING, INCORPORATED,

Petitioner,

v.

SCHWARZKOPF DEVELOPMENT CORPORATION,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Second Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

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The True Question Presented

Whether an alleged disputed issue of fact can properly be raised as of right in the district court for the first time *after* summary judgment is granted and *after* a first request for reconsideration thereof has been fully considered on the merits and denied.

Rule 28.1 STATEMENT

Respondent advises, pursuant to Rule 28.1, that there are no applicable parent companies, subsidiaries or affiliates.

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BRIEF FOR RESPONDENT IN OPPOSITION

Statement of the Case

1. The District Court Granted Summary Judgment When Ti-Coating Failed To Assert A Disputed Issue Of Fact

This is an action to recover royalties due under a patent license contract. The license required payments by Ti-Coating if it made use of any of the inventions claimed in either of two patents.

No federal issues are involved. The action was commenced in the state court and was removed to the United States District Court for the Southern District of New York by virtue of diversity of citizenship.* The patent license agreement called for application of New York law.

Schwarzkopf brought two successive motions for partial summary judgment, each seeking royalties owed for operations during a different time period. The first partial summary judgment motion covered Ti-Coating's operations from June to November 1982 and was granted without opposition from Ti-Coating. The judgment was made final under Fed. R. Civ. P. Rule 54(b) and was paid.

At issue here is the second partial summary judgment motion and the Rule 54(b) judgment entered upon the granting thereof. That second motion covered Ti-Coating's operations for the period from November 1982 through September 1983. There was no dispute below either as to what Ti-Coating did or how much was owed as royalties (i.e. some $140,000), if royalties were due. The only disputed issue was whether at least one claim of one of the patents covered Ti-Coating's admitted activities.

Accompanying Schwarzkopf's motion was its Local Rule 3(g) statement of material facts. Ti-Coating filed its opposition to the summary judgment motion but included no affidavits and no statement of material facts

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* The petition is incorrect in asserting at page 5 that the action was initially commenced in the United States District Court.

for which it asserted existence of a "genuine issue to be tried." Instead, Ti-Coating conceded the truth of the facts asserted in SDC's Local Rule 3(g) submission.*

At the motion hearing, Judge Sand, noting the absence of opposing affidavits and the absence of a Local Rule 3(g) statement of factual issues in dispute, granted summary judgment. But, while so granting, Judge Sand afforded Ti-Coating an additional thirty days to seek reconsideration by filing opposing affidavits setting forth facts establishing the existence of a genuine issue of fact to be tried. Thereafter, Ti-Coating sought reconsideration by filing an affidavit of Andrew Pierce, a lawyer, and a letter, not an affidavit, by Dr. Blocher, a purported expert. No Local Rule 3(g) statement was annexed.

Several months later, Ti-Coating wrote to Judge Sand, enclosing selected "pertinent portions" of the voluminous record of a Patent and Trademark Office file in which that Office declined to allow "reexamination" of one of the licensed patents pursuant to 35

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* Local Rule 3(g) of the Rules of the United States District Court for the Southern District of New York states:
(g) Upon any motion for summary judgment pursuant to Rule 56 of the Federal Rules of Civil Procedure, there shall be annexed to the notice of motion a separate, short and concise statement of the material facts as to which the moving party contends there is no genuine issue to be tried. Failure to submit such a statement constitutes grounds for denial of the motion.
The papers opposing a motion for summary judgment shall include a separate, short and concise statement of the material facts as to which it is contended that there exists a genuine issue to be tried. All material facts set forth in the statement required to be served by the moving party will be deemed to be admitted unless controverted by the statement required to be served by the opposing party.

U.S.C. §302 (1984) et seq. of certain patent claims not here at issue.*

The district court issued its written opinion of July 9, 1985 denying reconsideration and adhering to the grant of summary judgment, ruling that there was no issue of fact that would bar summary judgment:

> [S]ummary judgment of this question is appropriate when no genuine issue as to any material fact exists which is necessary for resolution of the issue. (App. E-3)

The district court pointed out that under the applicable law, relying solely upon Federal Circuit precedent, the interpretation of the meaning of patent claim language is an issue of law whose resolution by summary judgment is entirely proper. The district court also pointed out that the affidavit submitted by Ti-Coating was defective, not being on personal knowledge of the affiant and not addressing the salient issue. The unsworn Blocher letter was relied upon by the district court as an admission by Ti-Coating. The portion of the Patent and Trademark Office file relied on by Ti-Coating was held to contain a mere conclusory opinion on an issue of claim interpretation, i.e. a legal issue, and hence did not raise an issue of fact.

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* That petition to the Patent and Trademark Office was filed by a third party and did not involve any of the patent claims asserted against Ti-Coating and did not involve at all one of the two licensed patents. A request for Reexamination is an administrative procedure before the U.S.P.T.O. wherein any person can request that the Patent Office review an already issued patent in light of prior art. A determination is then made by the Patent Office as to whether or not a substantial new question of patentability has been raised that warrants reexamination of any claim of the patent. 37 C.F.R. §§1.510 and 1.515.

2. After Losing The Summary Judgment Motion Initially And On A Motion For Reconsideration, Ti-Coating Filed A Second Request For Reconsideration, Including New Evidence

After losing the summary judgment motion and being denied reconsideration, Ti-Coating changed lawyers and filed a second request for reconsideration. This second request annexed new materials including the entire voluminous record of the unsuccessful reexamination proceeding, including portions of the prosecution history of the '703 patent and the various "prior art" patents and publications referred to therein.*

In its memorandum supporting the second request for reconsideration, Ti-Coating explained that it was adding new materials after grant of summary judgment and after denial of Ti-Coating's first request for reconsideration.

> This Court, *based upon an abbreviated record* of the P.T.O. proceedings before it ... construed the claims broadly to cover the new product. Because of the impact of this Court decision ..., a certified copy of the full re-examination proceeding before the P.T.O. is submitted herewith; this Honorable court is *respectfully requested to reconsider its decision* of July 9, 1985 *in view of this complete record* and further in view of the comments which follow. (emphasis added)

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* Continuing its failure to comply with the Local Rule, Ti-Coating still did not file a Local Rule 3(g) statement listing allegedly material facts in dispute.

In further explaining why the district court should again reconsider, Ti-Coating's supporting memorandum conceded that the "prosecution history" of the patent had not been seasonably submitted to the district court:

> This Court in rendering its decision did not have the benefit of the prosecution history of the Schwarzkopf patent.... The law is well settled that an invention must be construed in light of the prosecution history....*

By memorandum endorsement on September 12, 1985, Judge Sand denied the motion. In remarks from the bench (unreported), Judge Sand stated that he had already considered one request for reconsideration of his grant of summary judgment and failed to see any good reason why Ti-Coating should be allowed yet a third opportunity to show the existence of a triable issue of fact.

Upon entry of judgment under Fed. R. Civ. P. Rule 54(b), Ti-Coating appealed to the United States Courts of Appeals for both the Federal Circuit and the Second Circuit. The Federal Circuit ruled it had no jurisdiction to hear the appeal. The Second Circuit affirmed the district court's judgment, essentially *per curiam*, noting that the district court decision was rendered "on the basis of undisputed facts and applicable law." (App. B-1). Ti-Coating's motions to the Second Circuit for reconsideration and to compel the writing of a formal appellate opinion were each denied.

The Second Circuit declined to recall its mandate pending Ti-Coating's promised filing of this Petition.

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* Memorandum in support of Ti-Coating's second request to the district court for reconsideration of the grant of summary judgment, at page 8.

Reasons For Denying The Writ

1. The Evidence Ti-Coating Seeks To Rely Upon To Show A Disputed Issue Of Fact Was Not Properly Before The District Court

In its petition, Ti-Coating seeks to establish existence of a conflict between the law of the Federal Circuit and the law of the Second Circuit as to patent claim interpretation. According to the Petition, the district court, and hence the Second Circuit, declined to consider the impact of the prosecution history of the patents. But the alleged conflict doesn't exist. The entire prosecution history was never seasonably brought before the district court. Those excerpts that were seasonably provided by Ti-Coating were considered.

What we have, instead, is an argument based in large measure upon evidence which Ti-Coating chose to withhold and not present to the district court in a timely and proper fashion. Rather than showing the district court's failure to consider evidence properly put before it, the Petition highlights the alleged materiality of evidence Ti-Coating withheld until after it lost on summary judgment and lost again on a first request for reconsideration.

Ti-Coating has admitted that the district court could not have consulted the prosecution history of the patents because that history had not been before that

court:

> This Court in rendering its decisions [the decisions granting summary judgment and denying the first request for reconsideration] did not have the benefit of the prosecution history of the Schwarzkopf patent."*

The only reason the district court "did not have the benefit" of this evidence is that Ti-Coating chose not to supply it at the proper time. The failure to seasonably supply this material to the district court precludes appellate consideration thereof in a motion to overturn the holding. *River Plate and Brazil Conferences* v. *Pressed Steel Car Co.*, 227 F.2d 60, 63 (2d Cir. 1955); *Ring Engineering Co.* v. *Otis Elevator Co.*, 179 F.2d 812 (D.C. Cir. 1949); *Surkin* v. *Charteris*, 197 F.2d 77, 79 (5th Cir. 1952). Given the size of the docket of this Court, as well as of the dockets of the district court and of the Second Circuit, the interests of reasonable judicial management preclude three bites of the apple in opposing a seasonably brought summary judgment motion.

Since the prosecution history was never seasonably placed before the district court, and since Ti-Coating did not seasonably assert any disputed issue of fact, summary judgment was properly granted by the district court and affirmed on appeal. See *Celotex Corp.* v. *Catrett*, 106 S. Ct. 2548 (1986).

The alleged failure of the district court to consider evidence not seasonably submitted does not evidence a

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* Memorandum in Support of Ti-Coating's Second Request to the District Court for Reconsideration of the grant of summary judgment, at page 8.

conflict between the circuits and certainly does not warrant review in this Court.

2. The Evidence Seasonably Submitted By Ti-Coating Did Not Meet The Requirements Of Fed.R.Civ.P. Rule 56(e) And Hence Could Not Have Precluded Summary Judgment

Ti-Coating argues that the district court failed to give proper weight to the opinion affidavit it submitted by a lawyer, Mr. Pierce (App. J.). But the opinions of a lawyer do not meet the requirements of Fed. R. Civ. P. Rule 56(e). Under Fed. R. Civ. P. 56(e), affidavits opposing a motion for summary jdugment are required to "be made on personal knowledge, shall set forth such facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify as to matters stated therein." Judged by this standard, Ti-Coating's opposing papers did not pass muster.

The Pierce affidavit shows no background or experience in the relevant field, i.e. metallurgy. Perhaps because of this lack of training in the relevant field, numbered paragraph 2 of the Pierce affidavit recites what Pierce says was told to him by one Al Pravel, a Ti-Coating employee. It also recites what was written in an unsworn letter sent by a Dr. Blocher. Based on this hearsay, i.e. on what Pravel and Blocher purportedly told him, Attorney Pierce states "his opinion", at App. J-5, about what happens when a titanium nitride coating is applied as an intermediate to a substrate. An opinion affidavit based upon hearsay information does not satisfy Rule 56(e). *Schiess-Froriep Corp.* v. *S.S. Finnsailor*, 574 F.2d 123, 126 (2d Cir. 1978); *Antonio v. Barnes*, 464 F.2d 584, 585 (4th Cir. 1972); 6 *Moore's Federal Practice*, 56.22[1] (2d ed. 1987).

Moreover, to be competent to give a scientific opinion, a witness must show at least some qualification in the scientific discipline involved.* Pierce showed neither competence nor personal knowledge of any facts. Hence, for that reason as well, numbered paragraph 2 of the Pierce affidavit does not satisfy Rule 56(e).

None of the Pravel or Blocher information relied on by Pierce is provided in affidavits; therefore, that information was not admissible under Rule 56(e) to defeat a summary judgment motion. *Union Ins. Soc'y of Canton, Ltd.* v. *William Gluckin & Co.*, 353 F.2d 946, 952 (2d Cir. 1965); *Automatic Radio Mfg. Co.* v. *Hazeltine Research*, 339 U.S. 827, 831 (1950). Moreover, the Blocher information could not have been the subject of an affidavit. Blocher's letter (App. K), while seemingly couched in scientific terms, turns out to be based strictly upon a "hunch." He wrote:

> I do not have the data at hand to make a quantitative prediction. However, my hunch is that ... the diffusion rate is slow enough to be in your favor. (App. K-2, last ¶).

The next paragraph of the Blocher letter goes on to point out that one of the assumptions underlying his scientific theory may not be accurate, but that he does "not have the data at hand to assess this factor."

If submitted in affidavit form, Blocher's "hunch" would not satisfy Rule 56(e). Pierce's opinion parrotting the unsworn "hunch" of Blocher likewise did not meet the requirements of Rule 56(e).

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* A witness may qualify as an expert by "knowledge, skill, experience, training or education." Fed. R. Evid. 702. The Pierce affidavit showed none of these.

Numbered paragraphs 3 and 4 of the Pierce affidavit state his opinion that the claims of the Schwarzkopf patents, when considered in view of certain references and in view of certain (unidentified) remarks by the applicant during patent prosecution and in light of the "principles" of certain Federal Circuit decisions, do not warrant a construction broad enough to cover Ti-Coating's operation. To give this opinion, Pierce here relied on what Ti-Coating Counsel purportedly told him about Ti-Coating's product and process. What that was is never divulged. This portion of the affidavit is likewise improper as founded on hearsay.

3. There Is No Conflict That Patent Claim Interpretation Is An Issue Of Law

The patent license agreement between the parties called for the payment by Ti-Coating of royalties on an article "which embodies an invention claimed in United States Patent No. 4,101,703 or which is made by or with the use of any method embodying an invention claimed in United States Patent No. 4,162,338." (App. F-3). Each claim (i.e. the numbered paragraphs at the end of each patent) of a patent constitutes a separate grant of monopoly, *Jones* v. *Hardy*, 727 F.2d 1524, 1528 (Fed. Cir. 1984), and is considered separately on the issue of infringement. *W.L. Gore & Associates, Inc.* v. *Garlock, Inc.*, 721 F.2d 1540, 1559 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Even overlooking the impropriety in Pierce's affidavit, the arguments therein did not raise an issue of fact. The issue of how a patent claim is to be construed is not an issue of fact. What a patent claim covers or how the claim must be interpreted, is a question of law. *Envirotech Corp.* v. *Al George, Inc.*, 730 F.2d 753, 758

(Fed. Cir. 1984); *Raytheon Co.* v. *Roper Corp.*, 724 F.2d 951, 956 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 835 (1984). A dispute as to claim construction or interpretation is not a bar to summary judgment on the issue of whether a patent claim covers a particular product or process. *Molinaro* v. *Fannon/Courier Corp.*, 745 F.2d 651, 654 (Fed. Cir. 1984):

> Claim interpretation, however, is an issue *of law* and a dispute respecting that issue does not preclude summary judgment...
>
> The ... affidavits thus create no issue of material fact. They are merely efforts to read the patent claims on the accused device in light of undisputed facts. That function, however, is the province of the district court.

Accord George v. *Honda Motor Co., Ltd.*, 802 F.2d 432, 434 (Fed. Cir. 1986).

There is no dispute between the Second and Federal Circuits on this point. The district court, and hence the Second Circuit, expressly acknowledged the Federal Circuit's *Molinaro* rule as controlling authority on the summary judgment motion. (App. E-3) This holding was a specific application of the general Second Circuit rule that where only a legal question is at issue, resolution by summary judgment is entirely proper. *Schwartz* v. *Compagnie General Transatlantique*, 405 F.2d 270, 274 (2d Cir. 1968).

Once the proper construction of the claims is arrived at, then the claims are applied to the accused device or process. If the claims, as construed, "read on" the accused product or process, "infringement is made out and that is the end of it." *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 U.S. 605, 607 (1950).

In an effort to avoid the impact of *Molinaro* and *Graver*, both cited and relied on by the district court but ignored in Ti-Coating's petition here, Petitioner points to out of context statements in other Federal Circuit decisions, i.e. *McGill Inc.* v. *John Zink Co.*, 736 F.2d 666 (Fed. Cir.), *cert. denied*, 469 U.S. 1037 (1984); P.M. *Palumbo* v. *Don-Joy Co.*, 762 F.2d 969 (Fed. Cir. 1985) and *Loctite Corp.* v. *Ultraseal Ltd.*, 781 F.2d 861 (Fed. Cir. 1985).

None of these cases support Ti-Coating's argument. *McGill* holds that there may be instances in which extrinsic factual evidence may be needed to explain the meaning of technical or scientific words used in patent claims. If the trial court decides as an issue of law that certain scientific terms require expert explanation, then he may, with appropriate instructions, leave resolution of any scientific disputes to the jury. See *McGill*, 736 F.2d at 672. At issue in *McGill* was the definition of the chemical term "recovered liquid hydrocarbon absorbent." The parties disputed what that term meant to persons skilled in the appropriate field. The *McGill* court said that a factual issue could arise only "if...the meaning of a term of art in the claim is disputed and extrinsic evidence is needed to explain the meaning." 736 F.2d at 672. Where the definition of scientific words used in the claims is not disputed, then "the district court could interpret or construe...claims as a matter of law." *Id.* at 671.

In *Loctite*, the meaning of the term "anaerobic" was disputed. The Court of the Federal Circuit held that interpretation of that term involved an issue of law which did not require deference to the trial court's determination. 781 F.2d at 866-67. While not involving summary judgment, *Loctite* follows the *Molinaro* rule, discussed

supra, under which a dispute as to patent claim interpretation is an issue of law, rather than an issue of fact.

In *Palumbo*, the issue involved a special "means plus function" patent claim. That type of claim is interpreted to include not only what is literally described but also what persons skilled in the art would have considered as "equivalent" to the description or "interchangeable" therewith. There was conflicting expert testimony as to whether "a neoprene sleeve and the superimposed unit" was functionally equivalent to the claimed "means for bracing the patella." *See Palumbo*, 762 F.2d at 974-76.

The case before this Court does not involve equivalents or a "means plus function" patent claim. Indeed Judge Sand pointed to the fact that he was not called upon to consider what might be equivalent, since Ti-Coating's product and process literally met the language of the patent claims under *Graver*. (App. E-7, n.1).

Nor is there any dispute as to the definition of a "term of art," i.e. scientific or technical term, appearing in the patent claims. There is no dispute over the fact that each element of the patent claims is found in defendant's product or process. Ti-Coating is disputing just the legal interpretation to be accorded the group of words, i.e. whether the presence of a miniscule intermediate layer in addition to what the claim expressly recites precludes a holding of literal infringement.

As a matter of patent law, the addition of an element to what is called for by a patent claim does not avoid the coverage of that claim:

> It is fundamental that one cannot avoid infringement merely by adding elements if each ele-

> ment recited in the claims is found in the accused device.

A.B. Dick Co. v. *Burroughs Corp.*, 713 F.2d 700, 703 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1042 (1984). *See also Amstar Corp.* v. *Envirotech Corp.*, 730 F.2d 1476, 1482 (Fed. Cir.), *cert. denied*, 469 U.S. 924 (1984). ("Modification by mere *addition* of the elements . . . whenever made, cannot negate infringement . . ."). *Accord Loctite Corp.* v. *Ultraseal, Ltd.*, 781 F.2d 861, 865 (Fed. Cir. 1985):

> Though PC 504 also includes components not required by the claims, such inclusion does not avoid infringement if the claims otherwise read on the accused product or process.

Moreover, Claim 15 of the '703 patent calls for an article "comprising" the recited elements. The term "comprising" is a term having special legal significance in patent law. It is a broad term that is used when the patent claim is intended to permit "the inclusion of other steps, elements or materials." *In re Baxter*, 656 F.2d 679, 686 (C.C.P.A. 1981). *See also Parmelee Pharmaceutical Co.* v. *Zink*, 285 F.2d 465, 469 (8th cir. 1961):

> The word 'comprising' in the patent law is an open-ended word and one of enlargement and not of restriction. Claim 17 includes the expression 'loose granules of a natural material of the group comprising wood and grain'. The word 'comprising' does not exclude other material beside wood and grains.

Squarely in point on virtually identical facts is *Azoplate Corp.* v. *Silverlith, Inc.*, 367 F. Supp. 711, 732 (D. Del. 1973), *aff'd*, 506 F.2d 1050 (3rd Cir. 1974), *cert. denied*, 421 U.S. 914 (1975). There, the court con-

sidered patent claims for photographic printing plates "comprising" a base and a light sensitive coating. The claims were held to be infringed as a matter of law by products having an intermediate layer, there called a "substrate," interposed between the required base and the required coating. Here, given use of "comprising" (App G-20) Claim 15 is likewise infringed when all of the recited elements are present plus one more intermediate layer.

4. File Wrapper Considerations Have No Relevance To The Issues At Bar

Much of Ti-Coating's argument deals with efforts to interpret the scope of the patent claims by reference to proceedings during patent prosecution, arguing an estoppel requirement.

The district court held this to be a case of "literal" infringement. Under Federal Circuit precedent, Petitioner's arguments notwithstanding, the doctrine of patent prosecution history estoppel is inapplicable as a matter of law in determining whether there is literal infringement. *Fromson* v. *Advance Offset Plate Inc.*, 720 F.2d 1565, 1571 (Fed. Cir. 1983):

> Advance and its customers argue that the "prime issue" in this appeal is the doctrine of prosecution history ("file wrapper") estoppel. That doctrine, however, is inapplicable here. If there be literal infringements, ... the doctrine is irrelevant.

Only where literal infringement is not found does a court need to consider whether there is infringement under the "equivalents" doctrine. And in assessing whether the accused article is an "equivalent" of the patented article the patent prosecution history must be

consulted. *Builders Concrete, Inc.* v. *Bremerton Concrete Products Co.*, 757 F.2d 255, 258 (Fed. Cir. 1985). Thus, for example, the patent claim language cannot be extended under the "equivalents" doctrine to encompass what has been conceded to be in prior art patents or publications. *Stewart-Warner Corp.* v. *City of Pontiac, Michigan*, 767 F.2d 1563, 1572 (Fed. Cir. 1985).

CONCLUSION

The Petition does not reveal a conflict among the circuits. Ti-Coating is attempting to create the mirage of a conflict by pointing to matters that were never properly presented to the district court. On the evidence properly presented, the district court's granting of summary judgment was entirely appropriate. This is not the type of dispute that warrants the issuance of a Writ of Certiorari.

It is respectfully urged that the Petition be denied.

Respectfully submitted,

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